

REMARKS

Claims 1, 2 and 4-17 are pending in this application. By this Amendment, claims 1, 7-13, 16 and 17 are amended. No new matter is added. Reconsideration and prompt allowance of the application based on the above amendments and the following remarks is respectfully requested.

The courtesies extended to Applicants' representatives by Examiner Renwick and his supervisor at the interview held July 16, 2008, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below, which constitute Applicants' record of the interview.

The Office Action rejects claims 1-5, 14 and 16 under 35 U.S.C. §103(a) over Gilboa (U.S. 5,853,327) in view of "Art of Fighting"¹; claim 6 under 35 U.S.C. §103(a) over Gilboa in view of Pepper Jr. (U.S. 4,302,011); claims 7, 15 and 17 under 35 U.S.C. §103(a) over Gilboa in view of Toshiyuka; claims 8-11 under 35 U.S.C. §103(a) over Gilboa in view of Watson (U.S. 5,821,916); and claims 12-15 under 35 U.S.C. §103(a) over Gilboa in view of Wang (U.S. 7,133,031). These rejections are traversed for at least the following reasons.

I. A Zoom Feature is Not a Correlating Area Setting Unit, as Recited in Claim 1, and Similarly Recited in Claims 7, 16 And 17

Claims 1, 7, 16 and 17 recite "generating an image of the game space including the whole correlating area so that the character is displayed regardless of the size of the correlating area and regardless of where in the placement detectable area a player places the formed object." This feature is supported in Figs. 4A and 4B and in the specification at paragraphs [0046], [0068] and [0069], for example. Therefore, a player can grasp the whole correlating area by looking at the game image. The player can easily understand where in the

¹ The Office Action rejects claim 3 and includes a discussion explaining the rejection, although claim 3 has been canceled. The Office Action appears to have repeated the same rejection from the previous Office Action.

game image the character will be displayed when the formed object or the printed matter is placed at any position in the placement detectable area.

Gilboa fails to disclose this feature. Gilboa teaches placing the sheet 11 having a map printed thereon on the board 8 (Figs 1 and 2). However, the game screen of Gilboa does not display the whole of the map that is printed on the sheet 11. When placing the figure 10 on the sheet 11, the player looks at the sheet 11, not the game screen.

As discussed during the interview, the Art of Fighting does not overcome Gilboa's deficiency, as discussed in more detail below.

Regarding the Art of Fighting, the Office Action asserts the following:

"[A] variable gamespace area that dynamically changes the area of the gamespace in accordance with events [sic]. This concept is well known in the art, especially in fighting games that use the camera zoom feature. The video game 'The Art of Fighting' was the first to teach a camera zoom effect wherein when the two players are close together, the camera is zoomed in on the two players, and when two players are far away from one another, the camera zooms out to include both players within the display screen."

However, as discussed and agreed to during the interview, a zoom feature as disclosed by the Art of Fighting is not a correlating area setting unit as recited in claim 1 and similarly recited in claims 7, 16 and 17. In particular, as discussed during the interview, the zooming in or out of a virtual camera as disclosed by the Art of Fighting does not correspond to the recited correlating area setting unit.

More specifically, as discussed during the interview, the Art of Fighting discloses that the camera zoom is controlled so that the player character and the enemy character are always visible in the screen. Therefore, if a player character moves further to the left when the player character is already at the left side of the screen, and if the enemy character does not substantially change its position, that is, if the distance between the player character and the enemy character increases, the virtual camera would zoom out so that both the players character and the enemy character remain within the screen.

According to claims 1, 7, 16 and 17, the motion and movement of the character is controlled in the correlating area, size of which is discretionarily set. The image of the game space is generated so as to include the whole correlating area. Thus, regardless of where in the placement detectable area the placer places a formed object, the formed object would appear in the image already displayed.

In view of the above, and as agreed to during the interview, the relied-upon zooming feature does not correspond to the claimed correlating area setting unit. Thus, Gilboa and Art of Fighting, as explained by the Office Action and the internet article enclosed with the Office Action and cited in the List of Cited References, individually or in combination, do not disclose or suggest the subject matter recited in claims 1, 7, 16 and 17.² Claims 2, 4-6, 8, 10, 12, and 14 depend from claim 1 and claims 9, 11, 13 and 15 depend from claim 7. Withdrawal of the rejections of claims 1, 2 and 4-17 is respectfully solicited.

II. It Would Not Have Been Obvious to One of Ordinary Skill in the Art at the Time of the Invention to Combine Gilboa with Art of Fighting

The Office Action asserts that it would have been obvious to combine Gilboa with Art of Fighting as follows:

"Because the structure of the claim limitations are already met by the invention of Gilboa, one skilled in the art would recognize that changing the particular game or game parameters that Gilboa is instructed to execute is merely changing the obvious variable component, that being the software.

² The Office Action does not provide a copy of Art of Fighting but instead provides an internet article allegedly published April 5, 2005, which does not support the rejection in the Office Action. In particular, the article does not support the assertion that Art of Fighting has a zoom feature. Accordingly, should any rejection relying upon Art of Fighting be maintained or newly asserted in a next Office Action, Applicants respectfully request that the Patent Office provide a reference or affidavit which supports the rejection. In this regard, Applicants note that 37 CFR 1.104 (d) 2 (cited in MPEP §707) states in part "[w]hen a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant or other persons." (emphasis added)

One can easily create a game with specific parameters that utilize the structural components of the invention, as Gilboa has previously disclosed a plurality of games including: a story book game, a game of chess, and a spaceship shooting game. To one skilled in the art the camera affect [sic] can be incorporated within the spaceship shooting game to show the perspective of the player in relation to the enemy space ship where as the player moves toward the enemy the display screen is zoomed in, and when the players move away from the enemy, the display screen is zoomed out, to show perspective. This similar effect can be used within the gamebook of Gilboa in which the display screen is zoomed in to encompass both the player and opposing character when the two are in close proximity. It would have been obvious to one skilled in the art to modify the invention of Gilboa with the camera zoom feature of 'The Art of Fighting' to add a dynamic element to a game that adds for better visual appeal and gameplay." (emphasis added)

However, Applicants respectfully submit that this alleged rationale for combining Gilboa and Art of Fighting is improper for at least the following reasons. First, the Office Action repeatedly states that one of ordinary skill in the art "can" or could have modified Gilboa as suggested by the Office Action (as emphasized above). This is not the legal standard for obviousness. 35 U.S.C. §103(a) states:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made." (emphasis added)

Thus, the test is whether one of ordinary skill in the art would have found the invention obvious, and not whether one of ordinary skill could have built the invention as disclosed in the application. Of course, with the benefit of hindsight, one of ordinary skill in the art can do many things which are otherwise non-obviousness. See MPEP §2143 (IV). Thus, Applicants respectfully submit that the Office Action's assertion of obviousness is improper, because it is based on knowledge gleaned only from Applicants' disclosure. MPEP §2145(X.A).

Second, the Office Action asserts, or strongly implies, that modifying software as suggested by the Office Action would have been more obvious than changing hardware. However, computer-readable mediums encoded with software are statutory subject matter. See MPEP §2106.01. Furthermore, Applicants know of no statutory preference for hardware over software inventions or any statutory presumption against the validity or non-obviousness of claims directed to inventions including software components. Accordingly, Applicants respectfully submit that Office Action's rejection is improper because it relies upon an unfounded presumption against claims directed to inventions including software components.

III. Regarding Claims 6 and 8-13 Gilboa, Pepper Jr., Watson and Wang, Individually or in Combination, Do Not Disclose or Suggest a Correlating Area Setting Unit, as Recited in Claim 1 and Similarly Recited in Claims 7, 16 and 17

Although the Office Action admits, on p. 3, that Gilboa fails to disclose a correlating area setting unit, and asserts that Art of Fighting supplies the subject matter missing from Gilboa, the Office Action does not assert that any of claims 6-13, 15 and 17 are rejected over Art of Fighting. Instead, the Office Action appears to repeat the rejections of these claims from the previous Office Action. Furthermore, while the explanation of the rejection of claims 7, 15 and 17 includes a copy of the explanation of how Art of Fighting allegedly discloses the recited subject matter (see pp. 8-10), the rejections in view of Pepper Jr., Watson and Wang do not include this explanation.

Accordingly, Applicants respectfully submit that Gilboa, Pepper Jr., Watson and Wang, individually or in combination, do not disclose or suggest a correlating area setting unit, as recited in claim 1 and similarly recited in claims 7, 16 and 17. Claims 6 and 8-13 ultimately depend from either claim 1 or 7. Thus, Gilboa, Pepper Jr., Watson and Wang, individually or in combination, do not disclose or suggest the subject matter recited in claims 6 and 8-13.

In particular, claims 8 and 9 recite that the displayed character is controlled to perform a predetermined action based on the turn direction and/or the amount of turn of the formed object or the printed matter obtained from the input system. This feature is described in the specification at, for example, paragraph [0106]. Claims 10 and 11 recite that the displayed character is controlled to perform a predetermined action based on the speed of the positional change of the formed object or the printed matter obtained from the input system. This feature is described in the specification at, for example, paragraph [0107]. Claims 12 and 13 recite that the displayed character is controlled to perform a predetermined action based on the path taken by the continuous positional change of the formed object or the printed matter obtained from the input system. This feature is shown in Fig. 18 and described in the specification at, for example, paragraph [0105]. None of the applied references teach or suggest these features.

Accordingly, withdrawal of the rejection of these claims under 35 U.S.C. §103(a) is respectfully solicited.

Because the Office Action does not reject any of claims 6 and 8-13 under 35 U.S.C. §103(a) over Art of Fighting, Applicants respectfully submit that any future Office Action rejecting any of claims 6 and 8-13 over Art of Fighting be made non-final, as raising a new ground of rejection. See MPEP §706.07(a).

IV. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 2 and 4-17 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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